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OFFICE OF PETITIONS

In re Application of
Gilliland, Torres, Anguelov, and Ward : DECISION DISMISSING
Application No. 10/015,103 : PETITION
Filed: December 11, 2001 :
For: Automatic power control and laser slope efficiency normalizing circuit :

This is in response to the Petition to Treat Declaration and Assignment as Being Signed by All Inventors Pursuant to 37 CFR 1.47, filed June 27, 2002, which is being treated as a petition under 37 CFR 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor.

The petition under 37 CFR 1.47 is dismissed as inappropriate.

Petitioner is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Renewed Petition under 37 CFR 1.47, and Petitions Under 37 CFR 1.48(a) and 1.183", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Address the renewed petitions to Petitions Attorney Derek L. Woods. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Background

The above-identified application was filed on December 11, 2001, with a List of Inventor's Names that listed five inventors. Also filed were two Declarations, the first listed three inventors, and the second listed one inventor. The fifth inventor identified in the List of Inventor's Names, David Schie, was not included on any Declaration filed with the Office.

A Request for Corrected Filing Receipt and a petition under 37 CFR 1.47 were filed on June 27, 2002. The Request for Corrected Filing Receipt requested the addition of inventor Schie to the application and requested a corrected Filing Receipt reflecting this addition.

On August 28, 2002, a Response to Request for Corrected Filing Receipt was mailed to Petitioner, informing Petitioner that changes made after submission of the executed oath/declaration to the inventor information other than correction of typographical errors must be submitted in the form of a substitute declaration, and that the change of inventorship requires a petition under 37 CFR 1.48.

This Decision addresses the petition under 37 CFR 1.47 and reiterates that a petition under 37 CFR 1.48 is required.

A petition under 37 CFR 1.47 is appropriate where the inventive entity has been established and when an inventor (37 CFR 1.47(a)), or all of the inventors (37 CFR 1.47(b)), refuse to sign the declaration or cannot be reached. A petition under 37 CFR 1.48(a) is required to correct the inventorship in an application after the oath/declaration has been filed and the inventive entity was set forth in error. Here, Applicant filed an oath/declaration that set forth three inventors, and a second oath/declaration setting forth a fourth inventor. The List of Inventor's Names is not an oath or declaration as required by 37 CFR 1.63, and is therefore not an acceptable method of identifying each inventor as required by 37 CFR 1.63(a)(2). The oath or declaration as filed, at best, identified four inventors.

Accordingly, the inventive entity was set forth, albeit in error as only four inventors were listed, and a petition under 37 CFR 1.48(a) is required to correct the inventorship. However, for reasons stated *supra*, a grantable petition under 37 CFR 1.48 requires an oath/declaration as permitted by 37 CFR 1.47. With the petition under 37 CFR 1.47, Petitioner has failed to provide an acceptable oath or declaration and thus the petition under 37 CFR 1.47 is not grantable.

A Petition under 37 CFR 1.48(a)

A grantable petition under 37 CFR 1.48(a) requires: (1) a request to correct inventorship that sets forth the desired inventorship change; (2) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part; (3) an oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or 1.47; (4) the processing fee set forth in § 1.17(I); and (5) if an assignment has been executed by any of the named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

As to item (2), in view of Petitioner's inability to obtain the signature of named inventors, Petitioner may be unable to comply with item (2) and obtain a statement from each person being added that the error in inventorship occurred without deceptive intention on his or her part. In that situation, petitioner must

request a waiver of 37 CFR 1.48(a)(2) by filing a petition under 37 CFR 1.183. Support for the waiver of 37 CFR 1.48(a)(2) would be in the petition under 37 CFR 1.47(a), where the inventor refuses to join the application. A petition under 37 CFR 1.183 would be in addition to the petition under 37 CFR 1.48(a).

As to item (3), Petitioner must submit an oath or declaration permitted by 37 CFR 1.47, which means Petitioner must also satisfy the requirements of a grantable petition under 37 CFR 1.47¹.

An oath or declaration as permitted by 37 CFR 1.47(a)

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

As to item (1), petitioner has failed to provide proof that inventor Schie refuses to sign the oath/declaration. Where it is alleged that an applicant refuses to join an application, the applicant must establish that the nonsigning inventor was presented with the application for signature. The Manual of Patent Examining Procedure ("MPEP") states that

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. Emphasis supplied.

MPEP 409.03(d).

Therefore, where it is alleged that an inventor refuses to join an application, the MPEP requires that a copy of the application is sent to the last known address of the nonsigning inventor(s). The last known address should be the last known residence at which the inventor customarily receives mail. See, MPEP

¹Petitioner is unable to submit an oath or declaration as required by 37 CFR 1.63, and 37 CFR 1.42 and 1.43 are inapposite.

409.03(e) and 605.03.

As to item (2), Petitioner has failed to provide an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116. A review of the declarations filed with the application reveals that one lists only three inventors, and the other lists only one inventor. As a result, we have two oaths or declarations for this application, each listing different inventors. As required by 37 CFR 1.63, the (single) oath or declaration must identify each inventor. "When joint inventors execute separate oaths or declarations, each oath or declaration should make reference to the fact that the affiant is a joint inventor *together with each of the other inventors indicating them by name.*" MPEP § 602. (Emphasis supplied).

Further to this, the Manual for Patent Examining Procedure ("MPEP"), section 409.03(a) provides:

All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.75 (see MPEP § 602, § 605.01, and § 1414) and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors *with the signature block of the nonsigning inventor(s) left blank* may be treated as having been signed by all the available inventors on behalf of the nonsigning inventor(s) unless otherwise indicated. (Emphasis supplied).

MPEP 409.03(a).

Multiple copies of the declaration may be filed; however, each declaration must list all inventors.

In sum, petitioner must:

(1) file a grantable petition under 37 CFR 1.48(a), including a declaration as permitted by 37 CFR 1.47, which means that Petitioner must;

(2) satisfy the requirements for a grantable petition under 37 CFR 1.47(a). To satisfy the deficiency, noted infra, petitioner must submit a properly executed oath or declaration as allowed by 37 CFR 1.47, listing all available inventors, and providing documentary evidence, based upon first-hand knowledge, of any inventors refusal to join the application.

Where petitioner is unable to comply with 37 CFR 1.48(a) (2), petitioner must request a waiver, which requires;

(3) a petition under 37 CFR 1.183 requesting waiver of 37 CFR

1.48(a)(2) (support for which is found in the grantable petition under 37 CFR 1.47(a)).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA 22202-3513

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Derek L. Woods
Petitions Attorney
Office of Petitions